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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.    | CONFIRMATION NO. |
|---|-------------|----------------------|------------------------|------------------|
| 10/647,998  | 08/26/2003  | John Pether          | 131279.1034 (B.036AUS) | 3085             |
| 60148 7590 01/14/2009<br>GARDERE / JHIF<br>GARDERE WYNNE SEWELL, LLP<br>1601 ELM STREET<br>SUITE 3000<br>DALLAS, TX 75201 |             |                      |                        |                  |
| EXAMINER<br>HYUN, PAUL SANG HWA   |             |                      |                        |                  |
| ART UNIT  |             | PAPER NUMBER         |                        |                  |
| 1797  |             |                      |                        |                  |
| MAIL DATE   |             | DELIVERY MODE        |                        |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/647,998

**Applicant(s)**

PETHER ET AL.

**Examiner**

PAUL S. HYUN

**Art Unit**

1797

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 18-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-17 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S5108)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The amendment filed on November 10, 2008 has been acknowledged. Claims 1-22 are currently pending wherein claims 3 and 18-21 remain withdrawn for being drawn to non-elected inventions. Applicant amended claim 1 and added new claim 22.

Despite the amendment, the rejections are maintained.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims **1, 2, 4, 5, 14-16 and 22** are rejected under 35 U.S.C. 102(b) as being anticipated by Lutenegger (US 4,474,066).

Lutenegger discloses a device for conducting load tests on soil samples (see line 51, col. 1). The device comprises a slit 44 for receiving a soil sample wherein the slit has a rectangular cross-section defined by a base 26, sidewalls 50 and 52, and an open top (see lines 31-47, col. 4). The device further comprises a top closure member 39 that applies a vertical pressure to the soil sample. The vertical pressure applied by member 39 resolves to form a horizontal pressure, which causes sidewall 52, which is resiliently biased, to move outwardly.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lutenegeger in view of Maddison (US 5,388,464).

Although Lutenegeger discloses the use of hydraulics to bias sidewall 52, the reference does not disclose the use of a spring.

Maddison discloses a device for conducting stress tests. The device comprises a piston to apply pressure to a sample. The reference discloses that the device can utilize either a hydraulic system or a spring to bias the piston (see Abstract). Because a spring is well known in the art to be a substitute for a hydraulic system, it would have been obvious to one of ordinary skill in the art to use a spring, including a leaf spring, to bias sidewall 52 disclosed by Lutenegeger.

Claims 7, 8, 12, 13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lutenegeger in view of Kellner (US 4,483,197).

Lutenegeger does not disclose windows, a heating, a cooling means, or a lining configured to minimize friction.

With respect to the windows, Kellner discloses an apparatus for testing soil (see Fig. 1). The apparatus is configured to exert pressure on the soil sample that is placed inside the apparatus. The apparatus comprises a housing that is made from a

transparent material to enable viewing of the sample (see line 65, col. 3). In light of the disclosure of Kellner, it would have been obvious to one of ordinary skill in the art to make at least a portion of the Lutenegger device out of a transparent material so that the sample can be viewed during testing.

With respect to the heating and the cooling means, the apparatus disclosed by Kellner further comprises a heater for heating the soil sample to simulate real-life soil temperatures (see lines 45-55, col. 5). In light of the disclosure of Kellner, it would have been obvious to one of ordinary skill in the art to provide the Lutenegger device with a heater so that it can also simulate real-life soil temperatures. Likewise, it would have been obvious to one of ordinary skill in the art to provide a cooling means to simulate cold conditions.

With respect to claim 17, Kellner discloses the use of an anti-frictional coating 15 to minimize friction between the soil and the container. In light of the disclosure of Kellner, it would have been obvious to one of ordinary skill in the art to coat the inner surface of the slit disclosed by Lutenegger with an anti-frictional coating to minimize the damage to the apparatus caused by friction.

Claims **9-11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lutenegger in view of Wissa (US 3,635,078).

Lutenegger does not disclose a port that is in communication with the slit.

Wissa discloses an apparatus for determining stress-strain properties of soil (see Figure). The apparatus comprises a chamber in which a soil sample is disposed, a

piston for applying axial pressure, and a plurality of ports 11 and 15 that are in communication with the chamber. Ports 15 introduce water into the chamber, enabling one to determine the swell pressure of the soil sample (see Abstract). Port 11 communicates the chamber with a pressure transducer so that the swell pressure can be determined (see lines 36-40, col. 2). In light of the disclosure of Wissa, it would have been obvious to one of ordinary skill in the art to provide ports that are in communication with the slit disclosed by Lutenegeger so that swell pressure of the soil sample can be determined.

### ***Response to Arguments***

Applicant's argument with respect to the claims has been fully considered but it is not persuasive. Applicant argues that the amendment, which specifies that the claimed invention is configured to simulate pressure testing of non-soil products buried in soil, patentably distinguishes the claimed invention from the apparatus disclosed by Lutenegeger because Lutenegeger does not disclose testing of non-soil products. This argument is not persuasive because the amendment is directed towards the intended use of the claimed invention, and thus it does not further limit the claimed invention. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this instance, the testing chamber (slit 44) disclosed by Lutenegeger appears to be capable of accommodating a

non-soil product. Thus, the apparatus disclosed by Lutenegeger is within the scope of the claim even though the reference does not teach testing non-soil samples.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL S. HYUN whose telephone number is (571)272-8559. The examiner can normally be reached on Monday-Friday 8AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul S Hyun/  
Examiner, Art Unit 1797

/Jill Warden/  
Supervisory Patent Examiner, Art Unit 1797